# REMARKS

Applicants respectfully request reconsideration of the present application based on the following remarks. Claims 1-2, 4-6, 9, 11-13, 16-17, 19-21, 24, 26-28, and 31-41 are pending in the application.

## *Claim Rejections Under 35 U.S.C. 103 in view of Havinis and Rosenthal*

Claims 1-2, 4, 6, 9, 11, 13, 16-17, 19, 21, 24, 26 and 28 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,134,447 to Havinis et al. ("Havinis") in view of U.S. Patent No. 5,737,701 to Rosenthal et al. ("Rosenthal"). For reasons set forth more fully below, Applicants respectfully traverse this rejection.

Applicants incorporate and restate prior arguments made in response to rejections made in previous Office Actions. Independent claim 1 explicitly requires (with similar limitations in each of the other independent claims 9, 16, and 24):

> A method for providing access to resources with the use of personal identification numbers, comprising the steps of:
>> **concurrently maintaining** a system-wide list of resources associated with a plurality of subscribers regardless of subscriber identity **and a separate and distinct** plurality of lists of resources respectively associated with subscribers;
>> receiving a request from a subscriber to access a resource;
>> **[1] first comparing the resource to the system-wide list;**
>> if the resource is included in the system-wide list:
>>> providing or denying access to the resource in accordance with the system-wide list;
>> **if the resource is not included in the system-wide list:**
>>> **retrieving one of the plurality of lists associated with the subscriber;**
>> **[2] next comparing the resource to the retrieved list associated with the subscriber;**
>> . . .
>> **[3] requiring the subscriber to input a personal identification number if the resource is not included in the list associated with the subscriber**

Thus, independent Claims 1, 9, 16, and 24 clearly require:

- Comparing a requested resource against both a system-wide list associated with a plurality of subscribers regardless of their identity and a list associated with the subscriber that is separate from the system-wide list,

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- A progression of first comparing the requested resource to a system-wide list associated with a plurality of subscribers and next comparing the requested resource to a list associated with the subscriber that is separate from the system-wide list if the resource is not in the system-wide list,

- Controlling access to a requested resource depending on its presence on a system-wide list associated with a plurality of subscribers then determining whether to require authentication for a requested resource depending on a subscriber-specific list.


Neither Havinis Nor Rosenthal Teach Checking A Requested Resource Against Both A System-Wide List Associated With A Plurality Of Subscribers Regardless Of Subscriber Identity And A Separate List Associated With A Particular Subscriber.

The independent claims all require comparing a requested resource against **both** a system-wide list associated with a plurality of subscribers regardless of subscriber identity **and** a **distinct** and **separate** list that is associated with a particular subscriber. The Office Action states that Havinis alone meets these limitations.[1] Applicants respectfully disagree.

Havinis teaches a service that allows the location of cell phone to be determined. Havinis's system discloses two forms of identification for location service subscribers and their cell phones: a location application identification number (LAIN) and a Mobile Station International Subscriber Directory Number (MSISDN). In Figure 4, relied upon in the Office Action, when a request for location service (i.e. apparently what the Office Action alleges is the requested resource) is received, Havinis teaches obtaining the LAIN identification of the requesting subscriber and checking it against a black list or gray list of subscribers (i.e. lists associated with subscribers) who, for example, have not paid their bills. If the LAIN is not on the black list, the system teaches obtaining the LAIN and/or MSISDN identification and checking whether a subscriber's profile (i.e. a list associated with the subscriber) indicates that location services should be prevented. If the subscriber is not on the black list, and the subscriber's profile does not prevent it, the location service is performed. Accordingly, Havinis merely teaches several lists specifically associated with subscribers' identities, and nowhere does Havinis teach or suggest checking or maintaining a system-wide list regardless of subscriber

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identity as required by the claims, much less concurrently with distinct and separate lists associated with subscribers.

For at least the foregoing reasons, the cited prior art fails to teach all the limitations of claims 1, 9, 16, and 24.

Neither Havinis Nor Rosenthal Teaches A Progression Of First Comparing The Requested Resource To A System-Wide List Associated With A Plurality Of Subscribers And Then Next Comparing The Requested Resource To A List Associated With The Subscriber That Is Separate From The System-Wide List If The Resource Is Not In The System-Wide List.

The independent claims all require that after receiving an access request for a resource from a subscriber, the steps of the method are to **first** compare the requested resource to a system wide list associated with a plurality of subscribers and to **next** compare the resource to a list associated with the subscriber **if the requested resource is not in the system-wide list**. Neither Havinis nor Rosenthal teaches such a progression of comparison.

As set forth above, Havinis merely teaches maintaining black lists and gray lists associated with subscribers' identities, and also maintaining profiles associated with subscribers' identities. Accordingly it is impossible for Havinis to meet this required sequence of first comparing a requested resource against a system-wide list.

Rosenthal is solely directed to the maintenance of lists associated to specific user characteristics. Nothing in Rosenthal suggests that the specific user lists must be compared to requested resources, much less **after an unsuccessful comparison to a system-wide list**, as required by claims 1, 9, 16, and 24.

Neither Havinis Nor Rosenthal Teaches Controlling Access To A Requested Resource If It Is On A System-Wide List, And If It Is Not On The System-Wide List, Determining Whether To Require Authentication For The Requested Resource In Accordance With A Subscriber-Specific List

Not only do the claims require concurrently maintaining separate and distinct system-wide list and subscriber-specific lists, but the claims clearly point out a unique fraud prevention process and system. Specifically, all the independent claims clearly require controlling access to

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[1] Applicants have previously demonstrated that Rosenthal does not meet these limitations.

a requested resource in accordance with a system-wide list, if it is on that list, and then if it is not, determining whether to request authentication for a requested resource depending on a subscriber-specific list.

More specifically, the **first** access control process includes "providing or denying access" to the requested resource in accordance with the system-wide list. The **next** access control process includes **requiring a PIN** to be entered if the resource is not on the subscriber's specific list, and also not on the system-wide list.

Havinis merely describes performing a location service if a subscriber's LAIN is not on a black list and if the subscriber's profile allows it. Rosenthal merely describes a process of determining whether authentication is required for a particular dialed phone call.

Meanwhile, independent claims 1, 9, 16 and 24 require a first access control process of "providing or denying access" to the requested resource in accordance with the system-wide list, and then a next access control process includes requiring a PIN to be entered if the resource is not on the subscriber's specific list, and also not on the system-wide list. For these additional reasons, claims 1, 9, 16 and 24 patentably define over the cited prior art.


The Alleged Combination Of Havinis and Rosenthal Would Not Suggest the Claimed Invention

The cited prior art does not establish a **prima facie** case of obviousness because all claim limitations are not present, even if the references are combined as alleged in the Office Action. Accordingly, it is not necessary to further address the alleged motivation to combine the references. Nevertheless, Applicants submit that the prior art does not suggest a motivation to combine or modify the references in a manner that could result in the invention. MPEP 2143.03.

As set forth above, neither Havinis nor Rosenthal teach or suggest the **concurrent** maintenance of **both** a system-wide list and a user specific list, or the progression of **first** comparing the requested resource to the system-wide lists, and **next** comparing the requested resource to a user specific list **if the requested resource is not in the system-wide list**. Accordingly, the alleged combination of Havinis and Rosenthal would not suggest all the limitations of independent claims 1, 9, 16, and 24 even if they could be combined as alleged in the Office Action. Accordingly, Applicants submit independent claims 1, 9, 16, and 24, together

with claims 2, 4-6, 11-13, 16-17, 19-21, 24, 26-28, and 31-41 that depend therefrom, patentably define over Havinis and Rosenthal.

<u>No Other Cited Prior Art Cures the Deficiencies of Chiniwala and Rosenthal With Respect to Independent Claims 1, 9, 16, and 24</u>

Claims 5, 12, 20, 27, 33, 36, 39, and 42 stand rejected under 35 U.S.C. 103(a) as being allegedly unpatentable over Havinis and Rosenthal in view of U.S. Patent No. 6,330,311 Mijares et al. ("Mijares"). Claims 31, 34, 37, and 40 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Havinis and Rosenthal in view of Rowell et al, WO 9704602 ("Rowell"). Claims 32, 35, 38, and 41 stand rejected as being allegedly unpatentable over Havinis and Rosenthal in view of Rudokas, US Patent 5,420,910 ("Rudokas"). These claims depend ultimately from independent claims 1, 9, 16, and 24 and thus are patentable for at least the reasons presented above. The deficiencies noted above are not cured by the alleged combinations with Mijares, Rowell, or Rudokas. Neither Mijares, Rowell, nor Rudokas teach or suggest the **concurrent** maintenance of **both** a system-wide list and a user specific list, or the progression of **first** comparing the requested resource to the system-wide list, and **next** comparing the requested resource to a user specific list **if the requested resource is not in the system-wide list** as required by claims 1, 9, 16, and 39.

*The Dependent Claims Further Patentably Define Over The Cited Prior Art*

Although patentable by virtue of their dependence on patentable subject matter, many of the dependent claims further define over the cited prior art.

For example, claim 2 depends from patentable claim 1 and further requires a "step of adding the resource to the list associated with the subscriber if the subscriber inputs the correct personal identification number."

The Office Action merely refers to col. 7 of 10-22 of Rosenthal which teaches:

> When processor 55 finds a match in automatic authentication database 102 for the MIN/ESN combination of the calling telephone and the destination number dialed by the caller, as determined in step 203, the authentication code entry requirement is waived and the call is then completed in step 209 in the conventional manner without further ado. Thereafter, in step 210, processor 55 may register the time and date, e.g., as derived from its

internal clock, of the accessing of the entry associated with the MIN and ESN combination of the calling telephone and the destination number dialed by the caller. Additionally, processor 55 may also increment the counter for that entry.

This merely suggests that a record of a call when a **matching** number is found in the authentication database, and when entering a PIN is **not required**. It does not suggest **adding** a new number to a list, much less after a successful PIN entry is **required and successfully completed**.
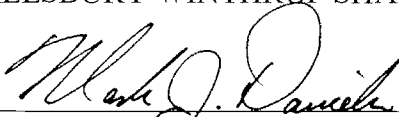
For at least these reasons, claims 2 and 17 further patentably define over the cited prior art and the rejections thereof should be withdrawn.

## *Conclusion*

All objections and rejections having been addressed, the application is believed to be in condition for allowance and Notice to that effect is earnestly solicited. If any issues remain which the Examiner feels may be resolved through a telephone interview, s/he is kindly requested to contact the undersigned at the telephone number listed below.

Respectfully submitted,
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